

REMARKS

Applicants note that all amendments, cancellations, and additions of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG),¹ and without waiving the right to prosecute the cancelled claims (or similar claims) in the future.

In the Office Action dated 12/12/05, the Examiner objected to Claim 35 as being a duplicate of Claim 34. The Applicants have canceled claim 35. As such, the objection is moot.

In the Office Action dated 12/12/05, the Examiner issued a number of rejections. Each of the rejections is discussed in detail below.

I. The Claims are not Obvious

The Examiner rejects Claims 1-15, 18, 20, 33, 35, 39-43, 48, 50, 73-77, 80-86 and 91 under 35 U.S.C. as allegedly being obvious in light of Lagu (Electrophoresis 20:3145 [1999]; herein after Lagu) in view of Holloway et al. (Analytical Biochem. 172:8 [1988]; hereinafter Holloway) in view of Hatt et al. (Eur J. Biochem. 246:336 [1997]; hereinafter Hatt) and further in view of Opiteck et al. (Anal. Chem. 69:1518 [1997]; hereinafter Opiteck), Davidsson et al. (Anal. Chem. 71:642 [1999]; hereinafter Davidsson) and Klimczak et al. (Plant Physiol. 105:911 [1994]; hereinafter Klimczak) (Office Action, pg. 4). The Applicants respectfully disagree with the rejection. Nonetheless, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have amended Claims 1 and 73 to include the elements of separation by isoelectric focusing and non-porous reverse phase HPLC and have canceled Claims 3-4, 6-7, 33-35, 39-43, 48, 50 and 80-81. The Applicants submit that none of the cited references, alone or in combination, teach the use of **non-porous** reverse phase HPLC. As explained in the specification (e.g., page 49), Experiments conducted during the development of the invention determined that non-porous reverse phase HPLC was compatible with the other aspects of the system (e.g., buffers) and that high recovery of proteins could be obtained, including larger proteins than was otherwise possible. The use of

¹ 65 Fed. Reg. 54603 (Sept., 8, 2000).

non-porous reverse phase HPLC also reduced the analysis times by as much as one third. Without hindsight knowledge of the present invention, there is no teaching in the cited references to make the claimed invention. The cited references do not teach or suggest, alone or in combination, every element of the claims as required for rejection under 35 U.S.C. 103. As such, the Applicants submit that prima facie obviousness is not established and respectfully request that the rejection be withdrawn.

II. The Claims are not Subject to Double Patenting

Claims 1-8, 33-35, 39, 48, and 50 are provisionally rejected under the judicially created doctrine of obviousness type double patenting over Claims 18, 20-24, 27-33, 35 and 37-47 of copending application number 09/968,930 (Office Action, pg. 7). The Applicants note that the present application includes executed assignments indicating the same common assignment. However, the assignment of one of the inventors in the present case was incorrectly recorded by the Patent Office. The present application currently reflects (incorrectly) complete assignment to a single assignee. The Applicants are in the process of correcting the assignment of the present application. Following correction of the assignment, the '930 application and the present application will correctly reflect common assignees and the Applicants will submit a terminal disclaimer.


III. The Claims Were not Invented by Another

The Examiner rejects Claims 1-8, 33-35, 39, 48 and 50 under 35 U.S.C. 102 (f) as allegedly not being invented by the Applicant (Office Action, pg. 8). The Applicants respectfully disagree. As described above, the present invention and the '930 application were commonly owned at the time of filing. The Applicants are in the process of correcting the recorded assignment documents to reflect the proper assignment of the '930 application. As such, the rejection is moot.

CONCLUSION

If a telephone interview would aid in the prosecution of this application, the Examiner is encouraged to call the undersigned collect at (618) 218-6900.

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